

**REMARKS****INTRODUCTION:**

In accordance with the foregoing, the Abstract has been amended, claims 52 and 61 have been cancelled without prejudice or disclaimer, claims 51 and 59 have been amended to incorporate the features of claims 52 and 61, and claims 65-69 have been added. No new matter is being presented, and approval and entry of the foregoing amendments and new claims are respectfully requested.

Claims 45-51, 53-60, and 62-69 are pending and under consideration. Reconsideration is requested.

**OBJECTION TO THE ABSTRACT:**

In the Office Action at page 3, the Examiner objects to the Abstract as not giving information on the applied usage of the invention. While it is respectfully submitted that the prior Abstract was sufficient within the word constraints imposed by the United States Patent and Trademark Office, the Abstract has been amended as suggested by the Examiner in order to set forth specific uses of aspects of the invention. However, it is understood that the scope of the invention is not limited by the Abstract and is defined in the claims.

**REJECTION UNDER 35 U.S.C. §112:**

In the Office Action at page 3, the Examiner rejects claims 45-64 under 35 U.S.C. § 112, second paragraph, since the Examiner asserts that the term "additional information" is an indefinite relative term. This rejection is respectfully traversed and reconsideration is requested.

In rejecting the claims, the Examiner asserts that the term "additional information" is not defined in the claims and that the specification does not provide a standard for ascertaining the scope of the invention. However, the Examiner does not provide evidence that the term "additional information" would be un-definable or un-ascertainable to one of ordinary skill in the art, and does not provide evidence of conflicting definitions in the art or as set forth in the claims so as to show such indefiniteness.

As a general principle, 35 U.S.C. §112, second paragraph, requires that the claims be written such that, in light of the specification, one of ordinary skill in the art would understand the metes and bounds of the invention with a reasonable degree of precision. As such, claims that otherwise appear indefinite when read in a vacuum can be made definite upon review of the specification. In re Moore, 1619 USPQ 236, 238-239 (CCPA 1971). The mere breadth of a

claim term does not render the claim non-compliant with the definiteness requirements of 35 U.S.C. §112. MPEP 2173.04. It is only when, in light of the specification and given their broadest reasonable meaning, a recited term that remains unclear to one of ordinary skill in the art is said to be indefinite for the purposes of 35 U.S.C. §112, second paragraph. In re Wiggins, 179 USPQ 421,423-424 (CCPA 1973), see also MPEP 2173.02 (May 2004 Rev).

Further, a claim term is indefinite where a meaning can have conflicting results, causing confusion to the person of ordinary skill in the art. Compare In re Moore, 1619 USPQ at 239 (term fluorinated is definite since all fluorination products produce the same type of product) with In re Wiggins, 179 USPQ at 423 (recited "heterocyclic group" is indefinite as encompassing groups having different properties than the claimed properties). Therefore, in order to establish a prima facie case of indefiniteness, the Examiner needs to provide evidence that a claim limitation, in view of the specification and the prior art as understood by one of ordinary skill in the art, would be sufficiently unclear as to not allow the person of ordinary skill in the art to understand the metes and bounds of the claim. See, MPEP 2173.02. It is respectfully submitted that the Examiner has not provided evidence of indefiniteness sufficient to maintain a prima facie indefiniteness rejection under 35 U.S.C. §112.

Moreover, it is respectfully submitted that one of ordinary skill in the art would understand that the term "additional information" in the context of the claims refers to information that is in addition to the contents. By way of example, claim 45 recites a contents and "additional information corresponding to the contents."

Lastly, while not restricted thereto, at least paragraph 0004 of the instant application sets forth specific examples of additional information. As such, it is respectfully submitted that the claims, with or without the examples set forth in the specification, provide sufficient guidance that one of ordinary skill in the art would be able to ascertain the metes and bounds of the applicants' invention as set forth in the claims. Therefore, it is respectfully requested that the Examiner reconsider and withdraw the rejection.

#### **REJECTION UNDER 35 U.S.C. §102:**

In the Office Action at pages 4-6, the Examiner rejects claims 51-57 under 35 U.S.C. §102 in view of Levy et al. (U.S. Patent No. 6,505,160). This rejection is respectfully traversed and reconsideration is requested.

As a point of clarification, claim 52 has been cancelled without prejudice or disclaimer. As such, it is respectfully submitted that the rejection of claim 52 is deemed moot.

By way of review, claim 51 recites, among other features, "a server for receiving a file including an identifier of predetermined contents from a reproduction apparatus for reproducing the contents, the file being prepared by and stored on the reproduction apparatus prior to transmission to the server, retrieving one of the additional information items corresponding to the contents identifier from the additional information data base, and transmitting the retrieved one additional information item to the reproduction apparatus," "wherein the contents identifier is recorded in at least one recording medium on which the contents are recorded."

In contrast, Levy et al. discloses retrieving a contents ID, such as an International Standard Recording Code (ISRC) directly from the contents, and transmitting the retrieved ID to a server 1 for use in retrieving linked data stored therein. (Col. 3, lines 24-29, col. 4, lines 33-67; FIG. 1). There is no suggestion that the ID is stored in a decoder using a file or other device, and that the stored ID is what is received by the server 1. As such, it is respectfully submitted that Levy et al. does not disclose or suggest the invention recited in claim 51.

Claims 53-57 are deemed patentable due at least to their depending from claim 51.

**REJECTION UNDER 35 U.S.C. §103:**

In the Office Action at pages 6-9, the Examiner rejects claims 45-50 and 58-64 under 35 U.S.C. §103 in view of Levy et al. and Leonhard et al. (U.S. Patent Publication No. 2002/52933). The rejection is respectfully traversed and reconsideration is requested.

As a point of clarification, claim 61 has been cancelled without prejudice or disclaimer. As such, it is respectfully submitted that the rejection of claim 61 is deemed moot.

On page 6 of the Office Action, the Examiner acknowledges that Levy et al. does not suggest the use of a Cookie file, and relies upon Leonhard et al. to teach the use of a cookie to transmit information. The Examiner further asserts on page 7 that one of ordinary skill in the art would use the cookie of Leonhard et al. to transmit the contents ID of Levy et al. since Leonhard et al. uses a cookie to get media information with ease over a network, and Levy et al. teaches communicating over a network using a web browser. However, it is respectfully submitted that there remains no evidence as to why one of ordinary skill in the art would modify the transmission of contents ID in Levy et al. by using a cookie as suggested in Leonhard et al.

Specifically, it is noted that Levy et al. does not suggest a need for storing the contents ID since the contents ID is already contained on the storage medium. As such, while the use of a web browser is suggested in Levy et al., Levy et al. suggests directly transmitting the contents ID by "one or more hops through a wire or wireless connection." There is no suggestion in Levy

et al. that this transmission method presents problems or that there is a need to store the ID in a location other than in the contents.

Further, Leonhard et al. suggests using cookies in the context of licensing music, where the cookie is used to identify the user and associated user data required to be automatically logged on to the server and/or for arriving at a license price. (Paragraph 0045, 0222, 416-418; FIG. 76 of Leonhard et al.) There is no suggestion that such a cookie should include a contents ID retrieved from corresponding contents.

Moreover, Leonhard et al. further suggests that any song identification is made by the user prior to purchase since Leonhard et al. teaches that such information is needed in order to search for the corresponding song stored on another server. (Paragraphs 0045-0049; FIGs. 1-3 of Leonhard et al.) As such, there is no suggestion as to an advantage in storing an identification of the contents since the contents have not been retrieved.

By way of contrast, Levy et al. teaches retrieving the contents ID from an already received contents such that it is unclear as to the need for the cookie, which is suggested in Leonhard et al. for use in obtaining music licenses for songs not already received.

As a general matter, in order to establish a prima facie obviousness rejection, the Examiner needs to provide both the existence of individual elements corresponding to the recited limitations, and a motivation to combine the individual elements in order to create the recited invention. Both the individual elements and the motivation need to be shown to have existed in the prior art. Should the Examiner fail to provide evidence that either one of the individual elements or the motivation does not exist in the prior art, then the Examiner has not provided sufficient evidence to maintain a prima facie obviousness rejection of the claim. MPEP 2143.03. Thus, the burden is initially on the Examiner to provide evidence as to why one of ordinary skill in the art would have been motivated to combine the individual elements to create the recited invention, and to demonstrate that this evidence existed in the prior art. MPEP 2143.01. In view of the above, it is respectfully submitted that there is insufficient evidence of a motivation as to why one of ordinary skill in the art would have combined Levy et al. and Leonhard et al. to achieve the invention as set forth in claim 45 as is required to maintain a prima facie obviousness rejection under 35 U.S.C. §103.

For at least similar reasons, it is respectfully submitted that there is insufficient evidence of a motivation as to why one of ordinary skill in the art would have combined Levy et al. and Leonhard et al. to achieve the invention as set forth in claims 58 and 59 as is required to maintain a prima facie obviousness rejection under 35 U.S.C. §103.

Claims 46-50 and 60-64 are deemed patentable due at least to their depending from corresponding claims 45 and 59.

**PATENTABILITY OF NEW CLAIMS:**

Claims 65-69 are deemed patentable due at least their depending from claim 45.

**CONCLUSION:**

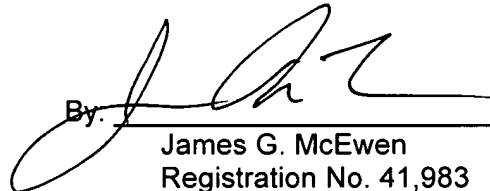
In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. And further, it is respectfully submitted that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney for a telephone interview to discuss resolution of such issues.

If there are any additional fees associated with the filing of this Amendment, please charge the same to our Deposit Account No. 503333.

Respectfully submitted,

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